

**REMARKS**

Claims 1 through 32, 34 through 66 and 68 through 75 are currently pending in the application.

Claims 1 through 31, 37 through 65, and 71 through 75 are withdrawn from consideration as being directed to a non-elected invention.

This amendment is in response to the Final Rejection in the Office Action of June 3, 2005.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Wark et al. (U.S. Patent No. 5,809,987)**

Claims 32, 35, 66, 67, 69 and 70 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wark et al. (U.S. Patent No. 5,809,987).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Wark et al. reference does not anticipate the claimed inventions of presently amended independent claims 32 and 66 under 35 U.S.C. § 102 because the Wark et al. reference does not identically describe each and every element of the claimed inventions in as complete detail as is contained in the claim.

Turning to the cited prior art, the Wark et al. reference describes a wafer cutting chuck used with a wafer cutting blade for cutting a semiconductor wafer into dice by dicing the wafer along the street indices.

Applicants assert that the Wark et al. reference does not identically describe the elements of the inventions set forth in presently amended independent claims 32 and 66 calling for

“sawing at least one semiconductor device from said substrate by laterally indexing of the saw using one of a multiple of a fixed interval and a variable interval”. The Wark et al. reference contains no description whatsoever regarding such an element of the presently claimed inventions. Therefore, presently amended independent claims 32 and 66 are allowable as well as dependent claims 34 through 36 and 68 through 70 therefrom respectively.

### 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent 5,809,987 to Wark et al. in view of U.S. Patent 6,102,023 to Ishiwata et al.

Claims 34, 36, 68 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wark et al. (U.S. Patent 5,809,987) in view of Ishiwata et al. (U.S. Patent 6,102,023).

Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicants assert that dependent claims 34, 36, 68, and 70 are allowable as they depend from allowable independent claims 32 and 66.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment places the application in condition for allowance.

The amendment does not require any further search or consideration as the amendments to independent claims 32 and 66 are set forth in the specification and drawings to clearly comply with the provisions of 35 U.S.C. § 132.

Applicants submit that claims 32, 34 through 36, 66, and 68 through 70 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 32, 34 through 36, 66, and 68 through 70 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan". The signature is fluid and cursive, with a long, sweeping underline.

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